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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/932,213

08/17/2001

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PALM.P863

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30554 7590 04/27/2009
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EXAMINER

NGUYEN, JIMMY H

ART UNIT

PAPER NUMBER

2629

MAIL DATE

DELIVERY MODE

04/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/932,213	Applicant(s) WEBB ET AL.	
	Examiner JIMMY H. NGUYEN	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-26 and 45-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-26 and 45-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is made in response to applicant's RESPONSE TO ELECTION REQUIREMENT AND AMENDMENT, filed on 02/12/2009.
2. Applicant's election without traverse of Group A in the reply filed on 02/12/2009 is acknowledged.
3. Applicant's election of Species IIIA in the reply filed on 2/12/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 19-26 and 45-50 are considered as follows:

Notice to Applicants

4. Claims 19-26 and 45-50 are NOT original claims and there is no drawing to explicitly show a mobile device defined by these current claims.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features must be shown or the feature(s) canceled from the claim(s):

“wherein an overall width of the mobile device is (i) maximized when the second segment is in the extended position, and (ii) minimized when the second segment is in the contracted position, so that the overall width of the mobile device is reduced when the second segment is moved towards the contracted position from the extended position” and “a set of one or more input mechanisms provided on the second segment so as to be exposed when the second

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segment is in the extended position and **NOT** when in the contracted position”, presently recited in last 10 lines of **claim 19**;

“wherein a portion of the display assembly that is overlaid by the **first** segment includes the immediate character recognition section” in last 3 lines of **claim 22**;

“wherein a portion of the display assembly that is overlaid by the **first** housing segment includes the second section” in last two lines of **claim 23**;

“wherein an overall width of the mobile device is (i) maximized when the second segment is in the extended position, and (ii) minimized when the second segment is in the contracted position, so that the overall width of the mobile device is reduced when the second segment is moved towards the contracted position as compared to when the second segment is in the extended position” recited in lines 4-9 of **claim 45** and “wherein when the second segment is in the contracted position, the first segment and the second segment are at least partially overlaid, so that access to at least one of either the multi-directional mechanism or the display assembly is at least partially blocked”, presently recited in last 4 lines of **claim 45**; and

“wherein the first segment overlays the second segment so that the display assembly covers at least a portion of the first input mechanism” of **claim 49**.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claim 23 is objected to because of the following informalities: "**the first housing segment**" should be changed to -- **the first segment** --, so as to make this feature consistent with feature in line 2 of independent claim 19. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 48-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 48 recites the limitation "the **first** input mechanism" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 49 recites the limitation "the **first** input mechanism" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

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9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 19-26 and 45-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Note that the invention of independent claim 19 or claim 45 is directed to an embodiment of a handheld computer (i.e., the claimed mobile device) comprising a housing assembly that is adjustable to affect a width of the handheld computer. The original disclosure, when filed, merely discloses a SINGLE paragraph (see the specification, page 21, last paragraph) regarding to the embodiment capable of varying a width of the handheld computer:

“While embodiments described above provide for housing segments to reduce a length of handheld computer 100, other embodiments **MAY** provide for a similar configuration to be used for a width of handheld computer 100, where lateral sides 105, 105 can be moved closer to or further away from each other by first segment 110 and second segment 120.” (emphasis added)

The above mentioned disclosure does not explicitly disclose what embodiment(s) may provide or may not provide for a similar configuration to be used for a variation in a width of a handheld computer. In other words, the above mentioned disclosure does not explicitly disclose the features, (1) a display assembly disposed or provided on the first segment 110 or the second segment 120; (2) input mechanism(s) disposed or provided on the first segment 110 or the second assembly 120; (3) the first segment overlays the second segment, the second segment

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overlays the first segment, or the first and second segments do not overlay each other; and other features as further discussed below.

As to claim 19, this claim contains the limitation, “a display assembly accessible on a front surface of the first segment” presently recited in line 3 of claim 19, which was not described in the original disclosure at the time the application was filed. As discussed above, the original disclosure (see the specification, page 21, last paragraph), corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach a display assembly disposed or provided on the first segment 110.

Further, this claim contains the limitations, “a second segment slidably coupled to the first segment ... from the extended position” presently recited in lines 4-11, which were not described in the original disclosure at the time the application was filed. As discussed above, the original disclosure (see the specification, page 21, last paragraph), corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitations.

Furthermore, claim 19 contains the limitation, “a set of one or more input mechanisms provided on the second segment so as to be exposed when the second segment is in the extended position and not when in the contracted position” presently recited in last 3 lines, which was not described in the original disclosure at the time the application was filed. As discussed above, the original disclosure (see the specification, page 21, last paragraph), corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its

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width, does not explicitly teach a set of one or more input mechanisms disposed or provided on the second segment (120) or the above underlined limitation.

As to claims 20-26, since these claims depend upon claim 19, these claims are therefore rejected for the same reason set forth in claim 19 above.

Additionally to claim 21, this claim contains the limitation, “wherein all of the display assembly is accessible to receive contact as input when the second segment is in the extended position”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitation of this claim.

Additionally to claim 22, this claim contains the limitations, “wherein the display assembly includes an immediate character recognition section configured to immediately recognize and display a character entry, and wherein a portion of the display assembly that is overlaid by the first segment includes the immediate character recognition section”, which were not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitations of this claim.

Additionally to claim 23, this claim contains the limitations, “wherein the display assembly includes a first section having a cross-section comprising a digitizer pad and a screen,

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and a second section comprising the digitizer pad without the screen, and wherein a portion of the display assembly that is overlaid by the first housing segment includes the second section”, which were not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitations of this claim.

Additionally to claim 24, this claim contains the limitation, “a midframe coupled to the first segment and the second segment”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitation of this claim.

Additionally to claim 25, this claim contains the limitations, “wherein the midframe the extended position” in lines 1-5, which were not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitations of this claim.

Additionally to claim 26, this claim contains the limitations, “wherein the midframe ... the extended position” in lines 1-8, which were not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure,

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specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitations of this claim.

As to claim 45, this claim contains the limitations, “a second segment moveably coupled to ... in the extended position” presently recited in lines 3-9, which were not described in the original disclosure at the time the application was filed. As discussed above, the original disclosure (see the specification, page 21, last paragraph), corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitation.

Furthermore, this claim contains the limitation, “a display assembly provided by the first segment” presently recited in line 10, which was not described in the original disclosure at the time the application was filed. As discussed above, the original disclosure (see the specification, page 21, last paragraph), corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach a display assembly disposed or provided on the first segment 110.

Furthermore, this claim contains the limitations, “a set of one or more input mechanisms provided on the second segment, ... blocked” presently recited in last 12 lines, which were not described in the original disclosure at the time the application was filed. As discussed above, the original disclosure (see the specification, page 21, last paragraph), corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its

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width, does not explicitly teach a set of one or more input mechanisms disposed or provided on the second segment (120) or the above underlined limitations.

As to claims 46-50, since these claims depend upon claim 45, these claims are therefore rejected for the same reason set forth in claim 45 above.

Additionally to claim 47, this claim contains the limitation, “wherein the multi-directional mechanism includes a set of one or more buttons”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitation of this claim.

Additionally to claim 49, this claim contains the limitation, “wherein the first segment overlays the second segment so that the display assembly covers at least a portion of the first input mechanism”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is capable of varying its width, does not explicitly teach the above underlined limitation of this claim.

Additionally to claim 50, this claim contains the limitation, “wherein the second segment is configured to slide towards and away from the first segment”, which was not described in the original disclosure at the time the application was filed. As discussed above, the above mentioned original disclosure, specifically the specification, page 21, last paragraph, corresponding to the embodiment that the handheld computer (or the claimed mobile device) is

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capable of varying its width, does not explicitly teach the above underlined limitations of this claim.

11. Claims 22 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 22-23, these claims recite a limitation, “a display assembly accessible on a front surface of the first segment” (see line 3 of independent claim 19), i.e., a display assembly being an element of the first segment (110). Claim 22 further recite a limitation, “wherein a portion of the display assembly that is overlaid by the first segment includes the immediate character recognition section” (see last 3 lines of claim 22), i.e., a portion of the display assembly does not belong to the first segment. Claim 23 further recite a limitation, “wherein a portion of the display assembly that is overlaid by the first segment includes the second section” (see last 2 lines of claim 23), i.e., a portion of the display assembly does not belong to the first segment. In other words, the original disclosure was not describe how the whole display assembly belongs to the first segment AND a portion of the display assembly does not belong to the first element, as presently claimed, so as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 19-21 and 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Lipponent et al. (US 7,412,258 B1), hereinafter Lipponent.

As to claim 19, Lipponent discloses a mobile device (a mobile station 1; Fig. 1; col. 4, line 35) comprising:

a first segment (a body housing element 2; Fig. 1);

a display assembly (a touch sensitive liquid crystal display 5; Fig. 1; col. 4, lines 46-48) accessible on a front surface of the first segment (Fig. 1); and

a second segment (a keyboard element 3; Fig. 1) slideably coupled to the first segment (2) to move between a contracted position (Fig. 2; col. 4, lines 18-20) and an extended position (Fig. 1; col. 4, lines 15-17), wherein an overall width of the mobile device is (i) maximized when the second segment is in the extended position (Fig. 1), and (ii) minimized when the second segment is in the contracted position (Fig. 2), so that the overall width of the mobile device is reduced when the second segment is moved towards the contracted position from the extended position; and

a set of one or more input mechanisms (keys of the keyboard; Fig. 1) provided on the second segment (3) so as to be exposed when the second segment is in the extended position (Fig. 1) and not when in the contracted position (Fig. 2).

Accordingly, all limitations of this claim are read in the Lipponent reference.

As to claim 20, Lipponent discloses the display assembly (5) is contact-sensitive (col. 4, lines 46-48).

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As to claim 21, Lipponent discloses all of the display assembly being accessible to receive contact as input when the second segment is in the extended position (Fig. 1).

As to claims 24-26, Lipponent further discloses the second segment (3) sliding in and out the first segment (Figs. 1-2; col. 4, lines 41-45), i.e., the first segment comprising an inherent midframe including a first rail engaging a first side (or the claimed first connecting member) of the second segment (3) and a second rail engaging a second side (or the claimed second connecting member) of the second segment (3) (Fig. 1), so that when the first and second sides are respectively engaged to the first and second rails, the first and second sides each moves a distance in the respective first and second rails to enable the second segment to move between the contracted position and the extended position (Figs. 1-2).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 45-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lipponent, and further in view of Kulp (US 4,803,474).

As to claim 45, Lipponent discloses a mobile device (a mobile station 1; Fig. 1; col. 4, line 35) comprising:

a first segment (a body housing element 2; Fig. 1);

a second segment (a keyboard element 3; Fig. 1) moveably coupled to the first segment (2) to move between a contracted position (Fig. 2; col. 4, lines 18-20) and an extended position

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(Fig. 1; col. 4, lines 15-17) , wherein an overall width of the mobile device is (i) maximized when the second segment is in the extended position (Fig. 1), and (ii) minimized when the second segment is in the contracted position (Fig. 2), so that the overall width of the mobile device is reduced when the second segment is moved towards the contracted position from the extended position;

a display assembly (a touch sensitive liquid crystal display 5; Fig. 1; col. 4, lines 46-46-48) provided by the first segment (2) (Fig. 1); and

a set of one or more input mechanisms (keys of the keyboard; Fig. 1) provided on the second segment (3), wherein when the second segment is in the contracted position (Fig. 2), the first segment and the second segment are at least partially overlaid, so that access to the set of one or more input mechanisms is blocked (Fig. 2).

Accordingly, the Lipponent reference discloses all limitations of this claim except for the set of one or more input mechanisms including at least a multi-directional mechanism having a plurality of actuation states, including one or more directional actuation states and a center actuation state corresponding to a central contact of the multi-directional mechanism, wherein the multi-directional mechanism is operable to enable the user to enter selection input, including input for selection of displayed data corresponding to any one or more of a menu item, a data entry, or an application being displayed on the display assembly, as presently recited in lines 11-18 of this claim.

However, Kulp discloses a keyboard comprising the set of one or more input mechanisms including at least a multi-directional mechanism having a plurality of actuation states, including one or more directional actuation states and a center actuation state corresponding to a central

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contact of the multi-directional mechanism, wherein the multi-directional mechanism is operable to enable the user to enter selection input, including input for selection of displayed data corresponding to any one or more of a menu item, a data entry, or an application being displayed on the display assembly (Figs. 3-4; col. 3, lines 53-62; col. 4, lines 21-32). It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to utilize the multi-directional mechanism in the set of input mechanism of Lipponent, in view of the teaching in the Kulp reference, because this would the operator quickly, easily and intuitively select any one of several specially-marked and pre-programmed action points, as taught by the Kulp reference (col. 2, lines 18-25).

As to claim 46, Lipponent teaches the display assembly is contact-sensitive (col. 4, lines 46-48).

As to claim 47, Kulp teaches the multi- directional mechanism including a set of 9 buttons (Fig. 3; col. 3, lines 53-62).

As to claim 48, Lipponent in view of Kulp discloses the first input mechanism including a plurality of one or more mechanical input mechanisms (Fig. 1 of the Lipponent reference).

As to claim 49, Lipponent teaches the first segment (2) overlaying the second segment (3) so that the display assembly (5) covers at least a portion of the first input mechanism (Fig. 2).

As to claim 50, Lipponent teaches the second segment configured to slide towards and away from the first segment (Figs. 1-2; col. 4, lines 15-20).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bowen (US 5,502,460; see Figs. 15 and 18) and Susel (US 6,111,527; see Fig. 2)

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both disclose a related mobile device capable of varying the width of the device. Caprara (US 5,563,629; see Fig. 6) discloses a keyboard comprising a multi-directional mechanism (1).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jimmy H. Nguyen whose telephone number is 571-272-7675.

The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached at 571-272-7681. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jimmy H Nguyen/

Primary Examiner, Art Unit 2629